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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re: Gossweiler III, et al.

Application No.: 09/391,462

Examiner: G. Clinton

Filed: 9/8/99

Group Art Unit: 2154

**Title: INTERACTIVE CONTEXT PRESERVED NAVIGATION OF GRAPHICAL
DATA SETS USING MULTIPLE PHYSICAL TAGS**

REPLY BRIEF

Appellants file this Reply Brief to correct a statement of the Examiner and to briefly clarify a couple of positions.

First, on page 9 of the Examiner's Answer, the Examiner states that:

Appellant alleges that "the Examiner has provided no reason" why a person of ordinary skill in the art would have been motivated to combine the Want (U.S. Patent No. 6,342,830) and Pulley (U.S. Patent No. 6,222,557) references (brief at p. 9.)

In response, the Examiner notes that the Appellant appears to have answered his own question: "To create an intuitive and flexible method for navigating a flexible N-space." (brief at p. 9.)

The Examiner is apparently attributing the phrase in quotation marks beginning "To create . . ." as Appellants' words. However, they are not. Appellants were quoting the Examiner. The entire quote is as follows:

The Examiner states, "A person of ordinary skill in the art, seeing the advantages Want's invention provides with respect to input devices, would have been motivated to combine it and Pulley's graphical navigation system to create an intuitive and flexible method for navigating a flexible N-space." Appellants ask why? The Examiner has asserted that a person skilled in the art could combine these references, but he has provided no reason why they would.

Appellant's Brief, page 9.

"To create an intuitive and flexible method for navigating a flexible N-space" are the Examiner's words, not Appellants'

Second, as the Examiner still fails to understand Appellants' arguments, I want to succinctly set them forth again.

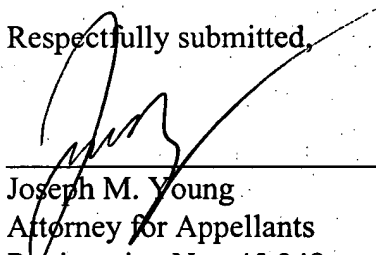
The Examiner has argued that US. Patent No. 6,342,830 to Want et al. and U.S. Patent No. 6,222,557 to Pulley et al. contain all the features of Appellants' inventions. The Examiner has also argued that the Want and Pulley references may be combined. However, the Examiner has provided no motivation for combining other than to achieve Appellants' invention. The Examiner has never identified a motivation for Appellants' invention in either

Want or Pulley. The Examiner's argument appears to be that if one wanted to create Appellants' invention, it would have been obvious to do so from Want and Pulley. However, the Examiner has never identified any portion of the references or the prior art generally that suggest the desirability of Appellants' invention. The Examiner has focused his argument on whether and how the references can be combined and not why they should be combined.

Further, the Examiner has repeatedly misunderstood Appellants' statements in arguing lack of suggestion to combine. Specifically, Appellants argued that ~~either~~ Want would need to suggest either Appellants' invention or (explicitly or impliedly) the elements disclosed in Pulley necessary to achieve Appellants' invention, or Pulley would need to suggest Appellants' invention or (explicitly or impliedly) the elements disclosed in Want necessary to achieve Appellants' invention. The Examiner apparently interpreted these arguments as an attack on the references individually. As should be obvious, this is not what Appellants were doing. Appellants were merely logically proving the Examiner's complete failure to identify a suggestion to combine them. The same clarification applies to Appellants' comments relating to the Biegel and Card references.

Accordingly, the Examiner has not established a prima facie case of obviousness. Thus, the Board of Appeals is respectfully urged to reverse all of the Examiner's rejections.

Respectfully submitted,



Joseph M. Young
Attorney for Appellants
Registration No. 45,248
(585) 423-4554

JMY/pn
Xerox Corporation
Xerox Square 20A
Rochester, New York 14644